

#28
DUB
5-1-02

201930US-7791-7791-25-X-CONT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :
DEATON ET AL. : GROUP ART UNIT: 2162
SERIAL NO. 08/935,116 :
FILED: SEPTEMBER 22, 1997 : EXAMINER: GRAVINI, S.
FOR: CHECK TRANSACTION PROCESSING
METHOD AND SYSTEM PROVIDING
SHOPPING AIDS

REPLY BRIEF

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

RECEIVED

APR 29 2002

Technology Center 2100

SIR:

This reply brief is filed in response to new issues raised in the Examiner's Answer mailed
06 March 2002.

I.

In response to paragraph (7) on page 2 of the examiner's answer, appellants note that claims 8-39 do not stand or fall together. In section VIII of the appeal brief, appellants have indicated with respect to each rejection whether the claims stand or fall together. To the extent that appellants have argued that claims do not stand or fall together because the added limitation(s) in the respective dependent claims are not disclosed or suggested by the cited references, the burden is on the examiner to show otherwise. In re Lee, _____ F.3d _____,

_____, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).

II.

With respect to the rejection of claims 8, 9, 12, and 13 as being anticipated under 35 USC 102(b) by Creekmore, the examiner states on page 11 three lines from the bottom-page 12 line 4 that:

Appellants state that the examiner is incorrect because a distinction is not made between the terminal for entering unique customer identification codes for customer information and means for allowing entry of customer transaction data. A distinction need not be made because, beginning at the first full paragraph of column 6, "input terminal 13 transmits customer-entered information, as well as machine-readable information obtained from the identification card 15, to the transaction processor 19." Examiner interprets this recitation, as read in the contents of Creekmore, to anticipate Appellants first two clauses (a terminal for entering and means for allowing) of claim 8.

In response, appellants submit that, contrary to the examiner's contention, terminal 13 of Creekmore is used for entering unique customer identification information from the customer presented at the terminal 13 (identification card 15 and pin number). In contrast, no transaction data is entered at terminal 13 of Creekmore (column 3 lines 32-33 and column 5 lines 37-45).

III.

With respect to the rejection of claims 33-39 as being anticipated under 35 USC 102(b)

by Goldman et al., the examiner states on page 12 lines 15-21 of the Examiner's Answer with reference to column 5 of Goldman et al. that: "A worthless check has a zero dollar amount which implicitly anticipates Appellants claimed transaction data including dollar amount. It is also implied in column 1, that merchants will cash checks after requesting a form of identification. The check cashing implicitly will carry a dollar amount since customers use checks for merchant purchases based on a dollar amount of goods and/or services. The same table at column 5 discloses the number of checks cashed during a current period. This current period disclosure anticipates Appellants claimed transaction data including time period."

In response, appellants submit that the table in column 5 of Goldman et al. fails to support the examiner's assertions the claimed limitations are implicitly disclosed therein. In fact, there is no disclosure in that table of a customer's prior transactions stored in association with a customer's transaction data including "dollar amount of purchases and time period" as recited in claim 33 or "total dollar amount of purchases purchased during a period of time associated with an identification of a customer" as recited in claim 34. In addition, there is no support for the examiner's assertions that the subject matter in dependent claims 35-39 is anticipated by Goldman et al.

IV.

With respect to the rejection of claims 10, 11, and 14 under 35 USC 103(a) as being obvious over Creekmore in view of Off et al. and Tai, the examiner has quoted from column 3 of Tai on page 17 of the Examiner's Answer. However, that quotation fails to make up for the deficiencies in Creekmore and Off et al. noted in appellants brief on page 23. The disclosure in

Tai relied upon by the examiner at most teaches that, if a prospective customer returns an encoded coupon, the retail establishment merely refines its mailing list. Tai does not teach or suggest generating a customer information response at the point-of-sale during the individual customer's transaction in the retail establishment upon detection of a unique identification code of the customer as set forth in claims 10, 11, and 14.

V.

With respect to the rejection of claims 17-32 under 35 USC 103(a) over Creekmore in view of Off et al., Tai, and Bigari, the examiner quotes from Bigari on pages 21 and 22 of the Examiner's Answer. However, the portion quoted from Bigari merely relates to the concept of pre-approving a maximum charge amount for a customer and requiring the customer to remove items from his or her shopping basket at the checkout counter if the cost of the items in the shopping basket exceeds the pre-approved maximum charge amount. That disclosure does not make up for the deficiencies in Creekmore, Off et al., and Tai with respect to the subject matter recited in claims 17-32. In particular, the Bigari disclosure does not teach or suggest (1) "a database storing transaction data from prior transactions for a plurality of customers, such that data regarding a customer's prior transactions are stored in association with identification of that customer" or (2) that "said customer information response signal depends upon data stored in said database indicating dollar amount of at least one prior purchase associated with said unique customer identification" as set forth in claim 17. The disclosure in Bigari relied upon by the examiner relates to activities that occur during the current shopping transaction. Independent claims 22, 27, and 30 also distinguish over the disclosure in Bigari for the reasons noted above

with respect to claim 17.

VI.

With respect to the rejection of claims 33-39 under 35 USC 101, the examiner states on page 23 of the Examiner's Answer that "Appellants have not argued that the amended claims clearly recite a useful, concrete, and tangible result." Contrary to this assertion by the examiner, appellants did argue on page 33 of the appeal brief that claims 33-39 provide a useful, concrete, and tangible result.

VII.

With respect to the rejection of claims 8, 9, 12, and 13 on the ground of obviousness-type double patenting, the examiner states on page 24 lines 17-23 of the Examiner's Answer that "The application claimed 'unique customer identification codes' is equivalent to the patented claim 'customer's unique customer identification codes' limitation. The second claimed feature, 'means for allowing entry of customer transaction data' is equivalent to the patented claim 'a terminal for entering unique customer identification codes from customer identification presented at the point of sale in a retail transaction' because customer identification code[s] are part of customer transaction data in both the application and the patent."

In response, appellants point out that the system disclosed in claim 23 of the '196 patent does not include (1) the "means for allowing entry of customer transaction data" or (2) or "a processor and a memory responsive to said terminal and to said means for allowing entry for creating a database for a plurality of the retail establishment's customers' transaction data from prior shopping visits...." The database recited in claim 23 of the '196 patent is used for entering

a customer's unique customer identification code so that the customer's identification code can be compared with a database to provide an up-to-date list of the store's customers. Claim 23 of the '196 patent further provides structure for comparing a list of the store's prospective customers with a list of the store's existing customers and to eliminate data with respect to the store's existing customers to thereby produce a non-customer database. Thus, the structure recited in claim 23 of the '196 patent does not teach or suggest either the "means for allowing entry of customer transaction data" or "a processor and a memory responsive to said terminal and said means for allowing entry for creating a database for a plurality of the retail establishment's customers' transaction data from prior shopping visits" as set forth in claim 8. Likewise, claim 23 of the '196 patent does not teach or suggest the corresponding limitations in claim 9.

VIII.

With respect to the rejection of claims 10, 11, and 14 on the ground of obviousness-type double patenting over claims 18 and 26 of the '010 patent in view of Tai, the examiner's discussion of Tai on page 26 of the Examiner's Answer at most indicates that the Tai disclosure is directed to a process for revising a mailing list. It does not teach or suggest "generating a customer information response at the point-of-sale during said individual customer's transaction in said retail establishment upon detection of a unique identification code of said individual customer, said response signal being related to said individual customer's transaction data in shopping visits prior to the current shopping visit" as set in forth in claim 10. Accordingly, Tai fails to make up for the deficiencies in claims 18 and 26 of the '010 patent with respect to the subject matter in claim 10 or the corresponding subject matter in independent claim 11.

IX.

With respect to the rejection of claim 15 and 16 on the ground of obviousness-type double patenting over claim 12 of U.S. patent No. 5, 659,469, the examiner continues to assert on pages 27-30 of the Examiner's Answer that this rejection is based on In re Schneller, 158 USPQ 210 (CCPA 1968). However, at least one panel of the board (Stoner, Chief Administrative Patent Judge, and Harison and Nase, Administrative Patent Judges) has held that In re Schneller does not set forth another test for determining "obviousness-type double patenting."¹ Thus, appellants submit that the only question involved with respect to this rejection is whether claims 15 and 16 are patentably distinct from claim 12 of the '469 patent. Appellants note that the examiner's comparison of claims 15 and 16 with claim 12 of the '469 patent on pages 27 and 28 of the examiner's answer does not use the exact terminology used in either claims 15 and 16 or claim 12 of the '469 patent. Moreover, the examiner has not explained why the recitations in claims 15 and 16 would have been obvious from the recitations in claim 12 of the '469 patent. For example, at the bottom of page 27 and the top of page 28 of the Examiner's Answer, the examiner asserts that certain purported recitations in the patent claim are equivalent to certain purported recitation in claims 15 and 16. However, the test is not equivalence but obviousness, and appellants submits that, when the actual language claims 15 and 16 is compared with the actual language in claim 12 of the '469 patent, it is clear the subject matter in claims 15 and 16 is patentably distinct from the subject matter in claim 12 of the '469 patent for the reasons stated by appellants in their main brief.

¹See Ex parte Davis, 56 USPQ2d 1434, 1436 (PTOBPAI 2000) (non-precedential).

X.

With respect to the rejection of claims 17-32 on the basis of obviousness-type double patenting over claims 1 and 3 of U.S. patent 5,529,560, appellants note that this rejection should be summarily reversed because the examiner has relied upon the wrong patent. That patent does not name any of the inventors of the present application, and it is not assigned to the assignee of the present application. U.S. patent No. 5,529,560 issued to D. Robert Davies, III and David Dise, and it is assigned to David Dise. That patent discloses physical fitness apparatus. It has nothing to do with the subject matter in claims 17-32 of the present application.

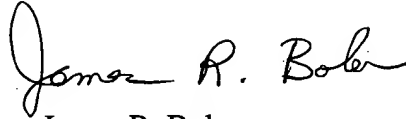
Appellants assume that the examiner intended to rely on claims 1 and 3 of U.S. patent No. 5,592,560 in the rejection of claims 17-32 on the ground of obviousness-type double patenting. For the reasons stated in their main brief, appellants submit that claims 17-32 are patentably distinct from claims 1 and 3 of U.S. patent No. 5,592,560.

XI.

With respect to the rejection of claims 33-39 on the ground of obviousness-type double patenting over claims 1, 2, and 3 of U.S. patent No. 5,592,560, the examiner on pages 33-36 of the Examiner's Answer continues to assert that this rejection is based on In re Schneller, supra. As noted above with respect to claims 15 and 16, appellants submit that, in accordance with Ex parte Davis, supra., the Schneller case does not describe a separate test for obviousness-type double patenting, and that the issue is simply whether the subject matter in claims 33-39 is patentably distinct from the subject matter of claims 1, 2, and 3 of the '560 patent. For the reasons stated in their main brief, appellants submit that claims 33-39 clearly patentably

distinguish over the subject matter of claims 1, 2, and 3 of the '560 patent.

Respectfully submitted,



James R. Boler
Registration No. 37,058
OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
1755 Jefferson Davis Highway, 4th Floor
Arlington, Virginia 22202
(703) 412-6262
(703) 413-2220 (facsimile)

Of Counsel

Charles L. Gholz, Esq.
Attorney of Record
Registration No. 26,395
OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
1755 Jefferson Davis Highway, 4th Floor
Arlington, Virginia 22202
(703) 412-6485
(703) 413-2220 (facsimile)

I:\interference\Old cases\7791cat\201930\020417 Reply Brief.wpd